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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,737	12/15/2005	Timo Heinrich	Merck-3100	1689
23599	7590	01/23/2008	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			JARRELL, NOBLE E	
			ART UNIT	PAPER NUMBER
			1624	
			MAIL DATE	DELIVERY MODE
			01/23/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/560,737	HEINRICH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Noble Jarrell	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 December 2005.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/15/2005.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Current Status of 10 / 560737***

Claims 1-14 are currently pending in the instant application and are being examined in the current office action.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the sole compounds and salts thereof, does not reasonably provide enablement for solvates and derivatives of compounds of claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants only show the preparation of the parent compounds and their salts. Applicants have not shown how to make and use any solvates or any other derivatives of the parent compounds. Derivatives of these compounds may include prodrugs, metabolites, and so on. In, addition, Vippagunta et al. (*Advanced Drug Delivery Reviews*, **2001**, *48*, 3-26) teaches that the formation of solvates is unpredictable due to the unique nature of each compound in a series of related molecules (page 18, section 3.4). Applicants are not enabled for the preparation of stereoisomers because all that is shown on the specification is compounds with a carboxamide moiety attached to a benzofuran ring.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What derivatives of the compounds are referred to? Are the derivatives prodrugs, metabolites, and so on? What alcohol protecting groups are being referred to in claim 4? Greene lists many types of protective groups for a hydroxyl group (*Protective Groups in Organic Synthesis*, 1999, chapter 2 table of contents, pages 17-23)

Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10-13 provide for the use of compounds of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9, and 14 rejected under 35 U.S.C. 102(b) as being anticipated by Bottcher et al. (US 5532241, published July 2, 1996, included in IDS). Bottcher et al. teach compounds of examples 1 (the original product), 4, and 9 (original compound produced as well as species 10-13 of the analogously prepared group). Compositions of these compounds are taught as well (column 7, line 66-column 8, line 23). Example 1 anticipates claim 1 because variables attached to the applicant's core, specifically  $R_1$  or  $R_2$  is methoxy (OA, where A is an alkyl group), variable m is 4, X is N, n is 0, and  $R_3$  is  $CH_2OH$  ( $CH_2R_4$  where  $R_4$  is OH). Example 4 anticipates claim 1 because  $R_1$  or  $R_2$  is cyano (or nitrile), m is 4, X is N, n is 0, and  $R_3$  is  $C(O)NH_2$  all attached to applicant's core. Since claims 5 and 14 are also compound claims, they are also anticipated. Claim 3 is anticipated because compound A of claim 3 is the same as the product of example 4. Step C of claim 4 is anticipated because in column 7, lines 31-49, it is taught that the compounds can be converted to salts by treatment with acid.

8. Claims 1-3, 5-9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bathe et al. (WO 02/102794, published 27 December 2003). Bathe et al. report a core structure in the abstract which anticipates applicant's compounds wherein  $R_1$  is cyano, m is 4, X is N, and  $R_3$  is  $C(O)NH_2$ . Compositions involving this compound are taught on page 25, lines 10-19. Since claims 5 and 14 are compound claims, this compound anticipates them as well. Claim 3 is anticipated because the structure taught is the species A of claim 3.

9. Claims 1-3, 5-10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartoszyk et al. (WO 02/39989, published 23 May 2002). Bartoszyk et al. teach a compound where R<sub>1</sub> or R<sub>2</sub> is cyano, m is 4, X is N, and R<sub>3</sub> is C(O)NH<sub>2</sub> as a serotonin reuptake inhibitor. Compositions involving this compound are taught on from page 8, line 16 to page 10, line 10. Since claims 5 and 14 are compound claims, this compound anticipates them as well. Claim 3 is anticipated because the compound is the same as species A of claim 3.

***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 4-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-14 of copending Application No. 10/560734. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims contain overlapping subject material and example 3 of application 10/560734 (page 21) can be encompassed by both sets of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1, 3, 4, and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 6 of copending Application No. 10/481270. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound claimed in copending application 10/481270 embraces by both sets of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1, 3, 4, 6, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 9, and 18 of copending Application No. 10/539516. Although the conflicting claims are not identical, they are not patentably distinct from each other because the second compound of example 5 of copending application 10/539516 (page 25) (the compound with a  $[M+H]^+$  of 414) embraces both sets of claims. This compound is species A of claim 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

If applicants have any other copending applications that overlap with the instant application, they are invited to report them.

### ***Specification***

14. The information disclosure statement filed 12/15/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Allowable Subject Matter***

15. No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble Jarrell whose telephone number is (571) 272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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